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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,620	07/07/2003	Eiji Murakami	P/3541-37	7497
2352 7590 04/29/2008 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER ANDERSON, GREGORY A				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
04/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/614,620

Applicant(s)

MURAKAMI ET AL.

Examiner

GREGORY A. ANDERSON

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) 5 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4 and 6-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 01222007, 02132008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claim 5 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7 March 2008.

Claim Objections

2. Claim 1 is objected to because of the following informalities: the phrase "at least supporting arms" appears to be in error for --at least two supporting arms--. Appropriate correction is required.
3. Claim 4 is objected to because of the following informalities: the phrase "said tip" in line 2 of the claim appears to be in error for --said jaw body-- and will be construed as such by the examiner. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Messerly 6,325,811.

Regarding claim 1: Messerly discloses an ultrasonic operating apparatus comprising: an elongate insert portion 150; an operating portion 180 located on a distal end portion of the insert portion; a handling portion 130 coupled to a proximal end portion of said insert portion, the handling portion having therein an ultrasonic vibrator; a covering tube 160 located around said insert portion; a vibration transmitting member 179 passed through the covering tube, the vibration transmitting member having an ultrasonic probe 88 on a side of said operating portion; a jaw 202 rockably supported opposite said ultrasonic probe and; a control handle 136 located in said handling portion and; and a handling force transmitting member 170 coupling said jaw and said control handle; and said jaw including a flame-shaped jaw body 202 having at least two supporting arms arranged individually on the opposite sides of a slot extending in an axial direction of said insert portion (Fig. 31), a tip 208, and a joint portion 212 removably coupling said tip between said supporting arms of said jaw body, wherein the jaw body is provided at the end portion of the insert portion and is attached to the tip so as to rotate therewith.

Regarding claim 2: Messerly further discloses the ultrasonic probe having an asymmetric curved portion curved with respect to a central axis of said insert portion (Fig. 23).

Regarding claim 3: Messerly further discloses the curved portion being formed symmetrically with respect to a direction in which said jaw is opened or closed (Fig. 23).

Regarding claim 6: Messerly discloses an ultrasonic operating apparatus comprising: a vibrator 179 for generating ultrasonic vibration; a probe 88 removably

mounted on the vibrator, the probe having an allowance portion for transmitting ultrasonic vibration from the vibrator to a distal end portion and for treating an organism tissue at the distal end portion with an ultrasonic wave; a distal end 202 acting portion mounted to be detachable from the allowance portion, the distal end acting portion having a jaw for seizing the organism tissue between the seizing portion and the allowance portion, and a seizing portion 208 attached to the jaw so as to rotate therewith (Figs. 30-31); and a locking portion operative to disengageably lock the seizing portion to the distal end acting portion, the locking portion being operative to release the seizing portion assembled with the distal end acting portion by using a dedicated tool (Figs. 30-31).

Regarding claim 7: Messerly further discloses the locking portion including: a locking member which utilizes elastic deformation for at least one of the distal end acting portion and the seizing portion; and a mechanism for locking both of the distal end acting portion and the seizing portion by means of the locking portion and for suppressing the elastic deformation in a locked state (Col. 11 ll. 15-24).

Regarding claim 8: the seizing portion of Messerly is capable of being released from the locked state by means of a dedicated tool.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messerly in view of duplication of parts.

Messerly discloses the invention essentially as claimed as disclosed in claim 1 above. Messerly further discloses the jaw body being designed so that support shaft portions 206A, 206B of the jaw body protrude inward and are removably inserted into mounting holes 173, and guide grooves (Fig. 36, just behind 171) for guiding the support shaft portions to the mounting holes and flange 171 serving as a click step portion for preventing the support shaft portions from slipping out of the mounting holes.

However, Messerly does not disclose mounting holes on the tip for the insertion of support shaft portions.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Messerly by duplicating the support shaft portions and mounting holes in order to cause the tip to lock into the jaw body.

8. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messerly in view of substitution of parts.

Regarding claim 9: Messerly discloses an ultrasonic operating apparatus system comprising: a vibrator unit 179 having a ultrasonic vibrator for generating ultrasonic vibration; a probe unit 88 which comprises an elongated vibration transmitting member having a proximal end portion removably connected to the ultrasonic vibrator and a distal end portion at which a distal end allowance portion is arranged, the probe unit transmitting the ultrasonic vibration generated by means of the ultrasonic vibrator to the distal end allowance portion; a handle unit 136 removably coupled with an operating

portion unit having a seizing member 208 supported to be detachable from the distal end allowance portion, the handle unit operative to operate the seizing member for the distal end allowance portion; an ultrasonic operating apparatus main body 20 with which the vibrator unit, the probe unit, and the handle unit are removably assembled. Messerly further discloses the tip, jaw, and vibration assembly being disposable (Col. 18 ll. 24-36), suggesting that the probe and operating unit are replaceable.

However, Messerly does not disclose a probe unit replacing member assembled to be replaceable with the probe unit with respect to the ultrasonic operating apparatus main body, the probe unit replacing member having the distal end allowance portion in a shape different from the probe unit.

It is well known in the art to make replaceable parts with an array of different shapes and sizes to facilitate the introduction of the device into different lumens of different patients. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the device of Messerly by replacing the probe unit with one of a different size and shape in order to facilitate the insertion of the probe into a different sized body lumen.

Regarding claim 10: Messerly further discloses the handle unit having a first handle 136 on a stationary side and a second handle 138 turnably mounted on the first handle, the vibrator unit and the probe unit being coupled with the first handle, respectively, and the operating unit being coupled with the second handle.

Regarding claim 11: Messerly further discloses the handle unit including an operating portion 136 for an operator to make operation; an insert sheath portion 160

having an elongated covering tube mounted on the operating portion; and a distal end acting portion 180 provided at a distal end of the insert sheath portion, the acting portion acting according to operation of the operating portion.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY A. ANDERSON whose telephone number is (571)270-3083. The examiner can normally be reached on Mon-Thurs 9:30am-3:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory A Anderson/

Art Unit: 3773

/(Jackie) Tan-Uyen T. Ho/

Supervisory Patent Examiner, Art Unit 3773